**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

42390P10466

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Signature

Typed or printed

name Kristin A. Morrow

Application No.

09/811,129

Filed

March 16, 2001

First Named Inventor

Kingsum Chow

Art Unit

2142

Examiner

Douglas B. Blair

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

NOTE: No more than five (5) pages may be provided.

I am the:

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under of 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ Attorney or agent of record.
Registration Number 58,330
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

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Telephone Number

April 19, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required.

☐ *Total of _____ forms are submitted.



Attorney Docket No.: 042390.P10466

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Chow, et al.

Application No.: 09/811,129

Filed: March 16, 2001

For: Geographic Location Determination
Including Inspection of Network Address

Examiner: Douglas Blair

Art Group: 2142

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action mailed October 19, 2005, and in conjunction with the Notice of Appeal filed concurrently herewith, Applicant respectfully requests review of the Final rejection of the claims of the above referenced application in view of the following.

The Final Office action mailed October 19, 2005 rejected claims 1, 3-4, 6, 14-15, 17-18, 20-21, 23, 31-32, 34-35, and 41-42 as being unpatentable over U.S. Patent No. 6,269,392 issued to Cotichini et al. (*Cotichini*). Claims 2, 5, 8-13, 16, 19, 22, 25-30, 33, 36-40 and 43 were rejected as being unpatentable over *Cotichini* in view of U.S. Patent No. 6,151,631 issued to Ansell et al. (*Ansell*). Claims 7 and 24 were rejected as being unpatentable over *Cotichini* in view of U.S. Patent No. 6,244,758 issued to Solymar et al. (*Solymar*). Applicant maintains that the Office actions have failed to teach each and

every element of the pending claims as is required both to support the 35 U.S.C. § 102 and § 103 rejections. However, claims 3, 4, 6, 7, 9, 10 and 17 are the focus of the Request.

Claim 3 recites, in part, validating said determined geographic location by performing at least one alternate determination for the network address. Claims 20 and 37 recite similar limitations. The cited portion of *Cotichini* (column 11, lines 3-25) does not discuss validating a determined geographic location by performing an alternate determination for the network address. It is questionable whether *Cotichini* even discusses determining a geographic location at all. *Cotichini* only discusses using an IP address to determine a location, but there is no suggestion that *Cotichini* is referring to anything other than a network location. *Cotichini* does not clearly teach or suggest identifying a geographic location. Regardless, the cited portion of *Cotichini* does not teach or disclose validating a determined geographic location by performing at least one alternate geographic determination for the network address. Thus, Applicant submits *Cotichini* does not anticipate claims 3, 20 and 37.

Claim 4 recites, in part, determining more than one geographic location of the network address and ranking the determined geographic locations in accordance with the number of alternate geographic location determinations. Claim 21 recites similar limitations. The Final Office action cites the same portion of *Cotichini* (column 11, lines 3-25) as teaching the limitations of claims 4 and 21. There is simply nothing in the cited portion of *Cotichini* that suggests determining more than one geographic location and ranking the determined geographic locations. The previous Office actions have merely

quoted the recited claim language and alluded to *Cotichini* as support for the rejection.

Thus, Applicant submits *Cotichini* does not anticipate claims 4 and 21.

Claim 6 recites performing a trace route from the server to the client. Claim 23 recites similar limitations. The Final Office cites *Cotichini* as teaching performing a trace route from the server to the client. Meanwhile, claim 7 recites performing a trace route from the client to the server. Claim 24 depends from claim 7. *Solymer* is cited as teaching performing a trace route from the client to the server. However, the cited portions of *Cotichini* and *Solymer* recite the **exact same** language.

Both references explicitly state that an agent “initiates a traceroute routine which provides the host with the Internet communication links that were used to connect the client computer to the host” (column 11, lines 4-7). Clearly there is a contradiction in citing the same prior art language against claims which recite performing a trace route from opposite directions. In any event, Applicant submits that the cited language in both *Cotichini* and *Solymer* fails to disclose both performing a trace route from the server to the client *and* performing a trace route from the client to the server. The language in both references merely discusses a traceroute routine without any suggestion as to the direction (client to server or server to client) in which the traceroute routine is performed. Thus, Applicant submits *Cotichini* does not anticipate claims 6 and 23. Applicant also submits *Cotichini* and *Solymer* do not render claims 7 and 24 obvious.

Claim 9 recites, in part, revising the estimated geographic location based at least in part on a second parsing. Claim 26 recites similar limitations. The Final Office action implies that *Cotichini* does not teach the limitations of claims 9 and 26 inasmuch as the Office action states that *Cotichini* does not teach or disclose parsing an identifier.

Applicant agrees that *Cotichini* fails to teach this limitation. *Ansell* is cited as teaching revising the estimated geographic location based at least in part on a second parsing, as claimed in claims 9 and 26. The cited portion of *Ansell* discusses “ad hoc” parsing of domain names but never reaches a discussion of parsing a network host identifier more than once (i.e., a second parsing). Furthermore, *Ansell* does not discuss revising the estimated geographic locations based at least in part in the second parsing. Given that the cited references fail to teach at least one limitation of claims 9 and 26, Applicant respectfully submits claims 9 and 26 are not obvious in view of *Cotichini* and *Ansell*.

Claim 10 recites, in part, revising the estimated geographic location based at least in part on a client profile associated with the client. Claim 27 recites similar limitations. As with claim 9, the Final Office action impliedly admits that *Cotichini* does not teach the additional limitations of claim 10. Applicant agrees. The same portion of *Ansell* (column 13, line 64 – column 14, line 63) is cited as teaching the additional limitations of claims 10 and 27. The cited portion of *Ansell* only discusses the procedure for “ad hoc” parsing, which does not include revising an estimated geographic location. Furthermore, *Ansell* does not teach or disclose revising the estimated geographic location based at least in part on a client profile associated with the client. *Ansell* simply does not discuss a client profile of any kind. Therefore, Applicant submits claims 10 and 27 are not obvious in view of *Cotichini* and *Ansell*.

Claim 17 recites, in part, filtering the log so as to remove undesirable network address, wherein undesirable network addresses comprise network addresses already having a known geographic location. Claim 34 recites similar limitations. *Cotichini* (column 11, lines 3-25) is cited as teaching the limitations of claims 17 and 34.

However, a discussion or disclosure that teaches filtering the log by removing network addresses already having a known geographic location is nowhere to be found in *Cotichini*. Given that *Cotichini* fails to disclose at least one limitation of claims 17 and 34, Applicant respectfully submits claims 17 and 34 are not anticipated by *Cotichini*.

The rejection of claims 3, 4, 6, 7, 9, 10, 17, 20, 21, 23, 24, 26, 27, 34 and 37 is shown above to be improper because the cited references, whether alone or in combination, fail to disclose or suggest at least one element of the independent claims. Therefore, these claims are not anticipated or rendered obvious by the references for at least the reasons set forth above.

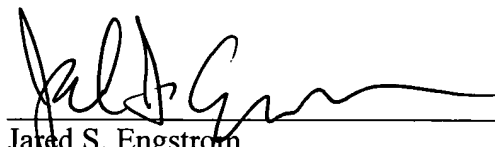
CONCLUSION

For at least the foregoing reasons, Applicant submits that the rejections have been overcome. Therefore, claims 3, 4, 6, 7, 9, 10, 17, 20, 21, 23, 24, 26, 27, 34 and 37 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: _____

4/19/06



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